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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,247	05/09/2001	Michael T. Rossi	A7966	3007

7590 10/21/2002
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EXAMINER

PAK, SUNG H

ART UNIT	PAPER NUMBER
2874	

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/851,247	ROSSI ET AL.	
	Examiner	Art Unit	
	Sung H. Pak	2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 22 July 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-10, 12-24, 26-37 and 39-41 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-10, 12-24, 26-37 and 39-41 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 22 July 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

DETAILED ACTION

In response to the applicant's amendment filed 7/22/2002, all the changes to the claims have been entered. Independent claims 1, 15, and 29 now contain subject matters from the cancelled claims 11, 25, and 38. Accordingly, the office action has been rewritten to accommodate the amended limitations, and a new ground of rejection is provided to reject the amended claims. Please note that the prior office action contained an inadvertent typographical error for the citation of "Fig. 3" on the bottom page 3-- the citation should have read "10% at 85 degrees Celsius (Fig. 2)." However, all the pending claims are rejected based on *the same ground of rejection- i.e. Risch et al (US 6,085,009) discloses, inter alias, the gel-swellable material swelling more than 10% at 85 degrees Celsius.* Therefore, the claim rejections are final. Please refer to Remarks for details.

Drawings

The corrected or substitute drawings were received on 7/22/2002. These drawings are acceptable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in–
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the

treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1, 12, 29, 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Risch et al (US 6,085,009).

Risch et al discloses an optical fiber cable with all the limitations set forth in the claims, including: an outer layer; at least one optical fiber disposed inside outer layer (Fig. 1); a gel-swellable material and water resistant gel positioned adjacent to each other and disposed between the outer layer and the optical fiber (Fig. 1); wherein the gel-swellable material swells more than 10% at 85 degrees Celsius (Fig. 2), and wherein the gel is a polyolefin oil based gel (abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-10, 13-14, 30-37, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risch et al (US 6,085,009) in view of Risch et al (US 5,911,023).

Risch et al ('009) discloses an optical fiber cable with all the limitations set forth in the claims, except it does not teach the gel-swellable material having density around 0.8-0.85 g/cc and the gel-swellable material being copolymers of polyethylene. Risch et al ('023), on the other hand, explicitly teaches such features (Fig. 5, column 8 lines 24-29, tables 2&3, column 10 lines 5-12, and column 9 lines 17-18). Risch et al ('023) explicitly teaches that such features are advantageous in producing optical fiber cables with improved strength, compression resistance, reduced shrinkage, increased solvent resistance, etc. (column 4 lines 5-10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Risch et al ('009) device to have gel-swellable material having density around 0.8-0.85 g/cc and the gel-swellable material being copolymers of polyethylene.

Claims 15-24, 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risch et al (US 6,085,009) and Risch et al (US 5,911,023).

Risch et al ('009) in view of Risch et al ('023) discloses an optical fiber cable with all the limitations set forth in the claims as discussed above, except it does not disclose the use of optical fiber ribbons. However, optical fiber ribbons are well known and

commonly used in the art. Fiber ribbons provide a well-known advantage over the individual fibers, because they allow for plurality of optical fibers to be organized in a smaller given space. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Risch et al devices to use fiber ribbons instead of individual fibers. It would have been desirable to have dense fiber optic cables.

Remarks

Rejection of claims 1, 12, 29, 39 under 35 U.S.C. 102(e) in view of Risch et al (US 6,085,009):

As an initial matter, the applicants argue that the claims are more properly rejected under 35 U.S.C. 102(a) and not 35 U.S.C. 102(e). However, the examiner points out that the '009 reference is a "a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent..." as stated in 35 U.S.C. 102(e). Therefore, the ground of rejection is maintained and the rejection based on 35 U.S.C. 102(e) is still proper.

The applicants argue that the '009 patent does not disclose gel-swellable material that swells more than 10% at 85 degree Celsius. The examiner respectfully disagrees. Figure 2 of the '009 patent explicitly shows gel-swellable material swelling more than 10% in various gels and base oils at 85 degree Celsius (Fig. 2 and column 5 lines 29-34). Although there had been an inadvertent typographical error in the figure citation in the prior office action on page 3 (citation to "Fig. 3" should have been "Fig.

2"), the same ground of rejection, *i.e. Risch et al (US 6,085,009) disclosing, inter alias, the gel-swellable material swelling more than 10% at 85 degrees Celsius*, has been maintained in this office action.

Then, the applicants argue that the '009 patent does not disclose the claimed subject matter because it is drawn "to provide a water blocking gel which does not cause excessive swelling." The examiner respectfully argues that, although this may be true (that the goal of the '009 device is to limit excessive swelling) the material disclosed in the '009 patent **nevertheless swells**. And because it swells, it is a **gel-swellable material**. Therefore, the recited claims fully read on the reference, and the claimed subject matter is fully anticipated by the reference.

Rejection of claims 2-10, 13-14, 30-37, 40-41 under 35 U.S.C. 103(a) over Risch et al (US 6,085,009) in view of Risch et al (US 5,911,023):

The ground of rejection for these claims have been changed due to amended limitations in the claims.

With regard to '023 reference, the applicants argue that the reference "promotes the use of higher MFI materials in an effort to reduce the amount of swelling in cable materials." The examiner respectfully points out that, although this may be true (that the goal of the '023 device is to limit excessive swelling) the material disclosed in the '023 patent **nevertheless swells**. And because it swells, it is a **gel-swellable material**. Therefore, the recited claims fully read on the reference, and the claimed subject matter is fully anticipated by the reference.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sung H. Pak whose telephone number is (703) 308-4880. The examiner can normally be reached on Monday - Thursday : 6:30am-5:00pm.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Sung H. Pak
Examiner
Art Unit 2874

sp
October 20, 2002



Rodney Bovernick
Supervisory Patent Examiner
Technology Center 2800